

APPLICANT(S): Elad Barkan
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1 through 13 have been rejected. Claims 1 through 13 have been canceled and replaced with new claims 14 through 28.

CLAIM REJECTIONS

35 U.S.C. § 112 Rejections

Applicants have canceled the rejected claims and a new set of claims is presented for examination.

35 U.S.C. § 102 Rejections

On pages 2 – 4 of the Office Action, in Paragraphs 3 -14 the Examiner has rejected claims 1 - 13 under 35 U.S.C. §102(a) as being anticipated by Deo, US Patent No. 5,721,781 ("Deo").

Deo discloses an authentication system and method for smart card transactions. Conversely, new independent claims 14 & 22 (currently on file) clearly recite the limitation of programming an electronic device with a document issuing method/program associated with a certifying authority. **Deo** doesn't disclose, teach or suggest this limitation. Programming an electronic device with a document issuing method that originates with a certifying authority is not suggested, taught or disclosed by **Deo**. As well established under

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U.S. patent law, for a reference to anticipate a claim, the reference must teach all elements of the claim.

Regarding Paragraph 4 of the office action, Examiner alleges that Deo *"discloses (the) programming the device with document issuing method that originates with an authority see Col 4 Ln 63 – Col 5 Ln 4;"*. Applicants fail to see how the cited paragraph is relevant to the programming of an electronic device with a document issuing method originating from a certifying authority (CA). For example, the cited paragraph discloses a smart card that *"contains multiple different applications and can be concurrently used in many different domains"*, and so on. Nowhere in the referred paragraph *programming an electronic device with a document issuing method associated with certifying authority* is disclosed, taught or suggested.

According to Deo *"digital certificates are assigned to the smart card, terminal, cardholder, each application on the card, and the application(s) stored on the terminal"* (Col. 5 Lines 63-65). This explicitly shows that digital certificates are assigned by a third party, rather than being generated inside/by the smart card itself. 'Assigned' indicates that the digital certificates are to be imported into the smart card from the involved CA party, which means that the smart card disclosed by Deo is incapable of generating digital certificate(s) on its own.

Furthermore, according to Deo, *"The certificate is issued by an independent and trusted third party, known as the "certifying authority"*". (Col. 6 Lines 1-2). Again, it is clear that digital certificates are issued by an independent and trusted third party, rather than being generated inside/by the smart card.

According to Deo, *"The terminal and smart card each prove their identity to the satisfaction of the certifying authority and deposit their public keys with this authority. In turn, the certifying authority issues a digital certificate that contains an expiration date, the holder's serial number, a public encryption key unique to the holder, information pertaining to the domain or environment within which the holder may operate"* (Col. 7 Lines 48-56). Therefore, It is thus clear that the certifying authority (CA) is always directly involved in every transaction in which the smart card is involved. In addition, using 'an expiration date' also implies that the CA itself has to issue digital certificates whenever

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required. *'Information pertaining to the domain or environment within which the holder may operate'* implies that not only that the CA has to directly certify individual transactions associated with a given application, but also the CA has to directly certify each application, as variously argued herein. Again, this implies that the Deo's smart card is incapable of generating digital certificate(s) on its own. In other words, according to Deo the CA is directly involved in the issuance of each digital certificate, whether the digital certificate is intended for transaction(s) associated with a given application, or for the application(s) itself/themselves.

In distinction to Deo, the present invention discloses programming an electronic device with a document issuing method. The document issuing method is a program approved by the CA for use by the smart card (*"The smart card operates according to a fixed program that was set according to rules governing CA"*, Page 6, par. 174). Using a CA-approved function or program (the 'document issuing method') by the smart card makes the smart card a representative of the CA that approved the document issuing method. That is, after the CA approves the document issuing method associated with it, and after the document issuing method so approved is programmed into the smart card, it may be said that the smart card has been authorized by the CA as a representative thereof (*"This method, in fact, transforms the smart card into a subcontractor of that known authority, for the purpose of issuing permits/certificates. Thus, the smart card now can issue permits/certificates in the name of the original CA authority."*, Page 3, pars. 84-85, and *"Each smart card contains software and a special permit from the CA allowing it to authenticate a user in the CA behalf"*, Page 8, par. 230, and *"Implementing a smart card containing a CA on a card 722, that is (should be 'has') a capability to perform the functions of CA as described by the original CA"*, Page 9, par. 292, and *"Thus, the smart card now can issue permits/certificates in the name of the original CA authority (Vise for example),...,"*, Page 9, par. 303).

Making a smart card a representative of a CA, by programming into the smart card an approved document issuing method (*"..., the device will operate as a certified authority according to the program or document issuing method that originates with the known authority"*, Page 9, par. 279), allows the smart card to issue digital certificates on its own (*"to the effect that the CA in this smart card is authorized to issue certificates,..."*, Page 6, par.

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180) as if the digital certificates were issued by the genuine CA. This means that the (genuine) CA is replaced by the smart card (which is "*backed by the authority of the certifying authority CA that established the method implemented in the smart card*", Page 3, par. 90) in issuing permit/certificates.

In view of the foregoing remarks, the all pending claims are considered allowable. Their allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3400.

Respectfully submitted,



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Dated: July 27, 2006
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